

REMARKS

Claims 1-20 were pending. Claims 1, 8 and 15 are rejected under 35 U.S.C. §112, second paragraph. Claims 1-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Sommerer (U.S. Patent Application Publication No. 2002/0143879).

Applicants cancelled claims 1-2, 4-9, 11-16 and 18-20 without prejudice or disclaimer. Hence, claims 3, 10 and 17 are pending in the Application. Applicants cancelled claims 1-2, 4-9, 11-16 and 18-20 only to expedite the issuance of claims 3, 10 and 17 and not in response to the Examiner's cited art. Applicants are not conceding in this application that cancelled claims 1-2, 4-9, 11-16 and 18-20 are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter (claims 3, 10 and 17) indicated by the Examiner as being likely allowable (see below). Applicants respectfully reserve the right to pursue these and other claims in one or more continuation patent applications.

Applicants amended claims 3, 10 and 17 to be rewritten in independent form and not to overcome prior art. Hence, no prosecution history estoppel arises from the amendments to claims 3, 10 and 17. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 3, 10 and 17 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicants thank Examiner Hussain for discussing the rejections to claims 3, 10 and 17 under 35 U.S.C. §102(e) as well as the rejections to claims 1, 8 and 15 under 35 U.S.C. §112, second paragraph, with Applicants' attorney, Bobby Voigt, on June 6, 2007. Examiner Hussain agreed that claims 3, 10 and 17 appear to be allowable. Examiner Hussain further agreed that by inserting the term "e-mail" prior to the term "message" in the first limitation of claims 1, 8 and 15, the rejections under 35 U.S.C. §112, second paragraph, will be removed. Applicants enclose herewith the

arguments that were presented during the discussion to refresh the Examiner's memory.

Please find below a synopsis of the discussion with Applicants' attorney regarding the rejections to claims 3, 10 and 17 under 35 U.S.C. §102(e).

Applicants respectfully assert that Sommerer does not disclose "clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message" as recited in claim 3 and similarly in claims 10 and 17. The Examiner cites paragraph [0040], lines 5-10 of Sommerer as disclosing the above-cited claim limitation. Office Action (3/20/2007), page 4. Applicants respectfully traverse.

Sommerer instead discloses that alternatively, when a current e-mail address is unknown, the e-mail application stores data indicative of the failed e-mail message delivery such that when the address book is provided with a current e-mail address for the destination individual, the user is automatically prompted to re-send each failed message to the now current e-mail address. [0040].

The Examiner agreed with Applicants' assertion that there is no language in the cited passage that discloses clearing an indicator. The Examiner further agreed that there is no language in the cited passage that discloses clearing an indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

The Examiner during the discussion with Applicants' attorney, Bobby Voigt, also cited paragraph [0038] of Sommerer in connection with the above-cited claim limitation. However, Sommerer instead discloses that the user is provided with an option of replacing the entered destination address with the newer address. [0038]. Sommerer further discloses that alternatively, the newer address is substituted for the expired address transparent to the user. [0038].

The Examiner agreed with Applicants' assertion that there is no language in the cited passage that discloses clearing an indicator. The Examiner further agreed that there is no language in the cited passage that discloses clearing an indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Please further find below a synopsis of the discussion with Applicants' attorney regarding the rejections to claims 1, 8 and 15 under 35 U.S.C. §112, second paragraph.

The Examiner rejects claims 1, 8 and 15 under 35 U.S.C. §112, second paragraph, because the claim limitation of "if failed delivery message is received" is allegedly indefinite. Office Action (3/20/2007), page 2. Applicants do not believe that this limitation is indefinite as there is support in the Specification (e.g., page 7, lines 4-6 of Applicants' Specification) for the claim limitation. Thus, the scope of claims 1, 8 and 15 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. According to M.P.E.P. §2171, a claim particularly points out and distinctly defines the metes and bounds of the subject matter if the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. Hence, claims 1, 8 and 15 particularly point out and distinctly define the metes and bounds of the subject matter. Nevertheless, the Examiner indicated that if Applicants inserted the term "e-mail" prior to the term "message" in the limitation of "if failed delivery message is received" that the Examiner would consider the limitation definite. While Applicants do not believe that this amendment is necessary to make claims 1, 8 and 15 definite, Applicants did amend claims 3, 10 and 17, when rewritten in independent form, to include the term "e-mail" prior to the term "message" in the limitation of "if failed delivery message is received" in order to expedite the issuance of claims 3, 10 and 17. Applicants assert that the insertion of the term "e-mail" prior to the term "message" does not change the scope of the claimed subject matter of claims 1, 8 and 15. Hence, no prosecution history estoppel arises from this amendment. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, this amendment was not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from this amendment. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 1, 8 and 15 under 35 U.S.C. §112, second paragraph, as being indefinite. As discussed above, by inserting the term "e-mail" prior to the term "message" in the limitation of "if failed delivery message is received," the Examiner has agreed to withdraw these rejections.

II. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 1-20 under 35 U.S.C. §102(e) as being anticipated by Sommerer. As discussed above, claims 1-2, 4-9, 11-16 and 18-20 were cancelled to expedite the issuance of claims 3, 10 and 17. The reasons for the allowance of claims 3, 10 and 17 are provided above to aid the Examiner.

III. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 3, 10 and 17 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, TX 75201
(512) 370-2832